

## **R E M A R K S**

### **A. INTRODUCTION**

Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81, 92-106 are pending and rejected.

Upon entry of this Amendment:

- Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81, 92-106 will be pending
- Claims 1, 56, 60, 69, 71, 75, 81 and 92-95 are the only independent claims

### **B. SECTION 101 REJECTION**

Claims 1, 4, 8, 9, 13, 15-18, 20-23, 28-34, 36, 37, 39-64, 69-71, 75, 81, 96-102 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Each of independent method claims 1, 56, 60, 69, 71, 75 and 81 have been amended to recite via a controller in electronic communication with at least one customer device (or merchant device, or wireless device). For at least this reason, Applicants submit that every pending method claim is tied to at least one particular apparatus.

Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106 are rejected because the claimed invention cannot produce a concrete result. Applicants respectfully traverse this grounds of rejection, which is baseless and has not been supported by substantial evidence made of record. However, to the extent the assertion that any awarding of a subsidy is not concrete relies on the Examiner's objection to the "different from" language (now removed), Applicants submit that the grounds is obviated.

For at least the above reasons, Applicants submit that the pending claims are directed to statutory subject matter. Applicants respectfully request the Examiner's reconsideration and withdrawal of the Section 101 rejection.

### **C. SECTION 112 ¶ 6 REJECTION: MEANS-PLUS-FUNCTION LANGUAGE**

The Examiner finds that Claims 93, 95, 104 and 106 do not comply with 35 U.S.C. § 112, sixth paragraph. Applicants neither agree nor disagree with this finding in this paper. Compliance with Section 112(6) is not required for the patentability of any pending claim. Applicants reserve the right to traverse the Examiner's finding in future papers, including on appeal.

**D. SECTION 112 ¶ 2 REJECTION: INDEFINITENESS**

Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which we regard as the invention. We respectfully traverse the Examiner's Section 112 ¶ 2 rejection of Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106, for at least the reasons stated in our prior reply.

Solely in order to expedite allowance of the present application, and reserving the right to argue the compliance of the disputed claim language with Section 112, Applicants have amended the independent claims to recite particular and desirable embodiments in which a subsidizer or third party is not a direct party to a first transaction. In some claims, the subsidizer or third party is also recited as not being a customer, at least one merchant, or restaurant.

Accordingly, the Examiner's concerns with respect to "ownership" are obviated. The specific type of subsidizer(s) or at least one third party recited in the claims is not a direct party to the first transaction (e.g., between a customer and a restaurant). Applicants submit that those of ordinary skill in the art will readily be able to ascertain the bounds of the claimed subject matter, and that all of the pending claims are fully in compliance with the requirements of Section 112(2).

**E. SECTION 102(E) REJECTION AND SECTION 103(A) REJECTIONS**

Claims 1, 4, 8, 9, 13, 15-18, 20-23, 28-34, 36, 37, 39-64, 69-71, 75, 81 and 92-106 stand rejected under 35 U.S.C. 102(e) as being anticipated by Chen (U.S. Patent No. 6,741,969). We respectfully traverse the Examiner's Section 102(e) rejection.

Claims 19, 24, 25 and 72-74 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chen. We respectfully traverse the Examiner's Section 103(a) rejection.

All of the Examiner's Section 102(e) and 103(a) rejections suffer from clear error and are not supported by substantial evidence made of record. The Examiner has not made the requisite findings that Chen teaches or suggests all of the claimed subject matter of any pending claim, and effectively admits that the prior art was not even considered with respect to features directed to:

the qualifying action concerns a purchase of a product of the  
subsidizer in a second transaction that is not the first transaction

as generally recited in independent Claims 1, 56, 60 and 92-95

the qualifying action concerns a purchase of a product of the third  
party entity in a second transaction that is not the first transaction

as generally recited in independent Claim 69, 71, 75 and 81

wherein the at least one merchant is a restaurant, and the subsidizer comprises at least one of an automobile dealership, a mortgage brokerage company, an investment company, an insurance company, a taxi service, a retailer, a department store, a magazine subscription company, a credit card provider, a telephone service provider or an internet service provider

as generally recited in dependent Claims 96-106.

The Office Action refers to MPEP § 2106.01 Computer-Related Nonstatutory Subject Matter as a basis for determining the recited subject matter “was not given patentable weight.” Applicants submit that at best MPEP § 2106.01 is directed to examination of claimed subject matter as a whole, and *per se* claiming of descriptive material. Applicants’ claims, however, are not claimed as descriptive material *per se*; the Examiner does not assert otherwise. Nor are Applicants claiming only “nonfunctional descriptive material...recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal,” which would not be statutory. Applicants are clearly claiming various methods, articles of manufacture, and apparatus, and not “agreements” *per se*.

Further, MPEP § 2106.01 suggests the selective elimination of claimed limitations employed by the Examiner, but only with respect to “printed matter.” The Examiner has not made a finding that the above features are “printed matter”; accordingly, the Examiner’s reliance on MPEP § 2106.01 is in appropriate. In summary, MPEP § 2106.01 provides no procedural basis or authority for the Examiner’s assertion that the specified features have no patentable weight.

In re Comiskey (revised opinion issued in January 2009) does not support the Examiner’s failure to consider the particular claimed features. Further, the CAFC did not consider the anticipation or obviousness of the claims at issue in Comiskey, but rejected the claims on Section 101 grounds. Even if the original September 2007 Comiskey opinion implicitly stated that any portion of an invention that would constitute nonstatutory subject matter would be considered *de facto* obvious, the revised 2009 Comiskey opinion removed those very phrases of the original opinion linking Sections 101 (subject matter) and 103 (nonobviousness).

Accordingly, the Office Action fails to follow the Graham requirements and does not establish a *prima facie* case of anticipation or obviousness of any of the pending claims. Applicants respectfully request the Examiner’s reconsideration and withdrawal of the Section 102(a) and Section 103(a) rejections.

**F. ADDITIONAL COMMENTS**

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

**G. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES**

We understand that a two-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: \$490.00

Deposit Account: 50-0271

Order No.: 00-101

Please credit any overpayment to the same account.

**H. CONCLUSION**

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mdowns@walkerdigital.com](mailto:mdowns@walkerdigital.com).

Respectfully submitted,

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